

Remarks

The claims have been amended to expressly clarify the patentability of the invention. Claims 1 and 14 were amended to make clear that the mouthpiece and the holder each consist of a single piece of molded plastic, and that the holder is inserted directly into the mouthpiece. Thus the apparatus necessarily has **only** two parts. Claims 1-5 and 8-13 were rejected over Grasso(US 3,313,308). Grasso's holder has at least two parts which are connected by legs and lugs. Therefore, Grasso meets neither the requirement that both the mouthpiece and the holder be a single piece of molded plastic, nor that there be only two parts. It is not pertinent whether the prior art device possess the functional characteristics of the claimed invention if the reference does not describe or suggest its structure (see ***In re Mills***, 916 F.2d 680, 16 USPQ2d 1430, 1432–33 (Fed. Cir. 1990)). Using only two parts each consisting of a single piece of molded plastic is a principal advantage of the invention since it simplifies the process of disassembly, cleaning, and reassembly.

Also, the invention uses two o-rings whereas Grasso uses only one o-ring and a seal held together with legs and lugs in place of the second o-ring. Neither Grasso alone or in combination with the other references teach using two o-rings. The test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. . . . Rather, we look to see whether *combined* teachings render the claimed subject matter obvious. (See ***In re Wood***, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979)).

There is no suggestion in the prior art to modify them to have a device with two parts wherein each part is made from a single piece of molded plastic.


“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” (quoting *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933

(Fed. Cir. 1984)). . . . The mere fact that the prior art *may* be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. ***In re Fritch***, 972 F.2d 1260, 23 USPQ2d 1780, 1783–84 (Fed. Cir. 1992).

Applicant believes that claims 1-12 and 14-18 are now in condition for allowance and therefore requests reconsideration and allowance of these claims.

If examiner desires to discuss any matter involving this case please contact the undersigned attorney at 510-785-8070 between 9 am and 5 pm PST.

Respectfully Submitted,

A handwritten signature in cursive script that reads "Howard E. Lebowitz".

Foothill Law Group LLP
Howard E. Lebowitz
Reg. No. 44864
19682 Hesperian Blvd., Suite 208
Hayward, CA 94541
510-785-8070